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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,463	04/13/1999	LEX M. COWSERT	ISIS-3455	7206

7590 03/12/2002

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 03/12/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/295,463

Applicant(s)
Cowser et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 27, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55, 56, 58-72, 74-87, and 99-102 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55, 56, 58-72, 74-87, and 99-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Applicants' arguments, filed 12/27/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 55, 56, 58-61, 72, 74-87, and 99 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite as to whether the preamble controls the metes and bounds of the claims or the actual steps control said metes and bounds. Claim 55, for example, indicates that the method is directed to defining a set of compounds. Then, in lines 4-7, compounds are generated. In lines 8, "some" compounds are synthesized. In lines 9-11, robotic assaying is performed for desired properties. No "defining" step is seen amongst these steps as set forth in the preamble. What defining criteria is meant? A similar unclarity is present for identifying in claims 72, 74-87, and 99. Clarification via clearer claim wording is requested.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 55, 56, 58-72, 74-87, and 99-102 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Agrafiotis et al. (P/N 5,463,564); taken in view of Uhlmann et al. (1990); taken further in view of Dower et al. (P/N 5,639,603); taken further in view of either of Haff et al. (P/N 5,720,923) or Harris et al. (P/N 5,650,122).

This rejection is reiterated and maintained from the previous office action, mailed 8/15/01. Applicants argue that there is insufficient motivation to combine the references but do not set forth any specific argument and thus is an allegation without factual support and moot regarding the rejection. Applicants then that the "in silico" limitation is not present in

regarding practices therein. In
describing computer
thereof of the type as
e other references thus
to the allegation of

ed.
to this application may be submitted to
Center 1600 by facsimile transmission. Papers should
Technical Center 1600 via the PTO Fax Center located
Mall 1. The faxing of such papers must conform with
notices published in the Official Gazette, 1096 OG 30
(November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG
94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center
number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier
communications from the examiner should be directed to
Ardin Marschel, Ph.D., whose telephone number is (703)308-3894.
The examiner can normally be reached on Monday-Friday from 8 A.M.
to 4 P.M.

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D.,
can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of
this application should be directed to Patent Analyst, Tina
Plunkett, whose telephone number is (703)305-3524 or to the
Technical Center receptionist whose telephone number is (703)
308-0196.

March 8, 2002

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER